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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,013	04/28/2005	Koushi Nakano	Saeg153.002APC	1676

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EXAMINER

Gemeniano, Malou C

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/533,013	Applicant(s) NAKANO ET AL.	
	Examiner Malou C. Gemeniano	Art Unit 1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-12, drawn to a nonbacterial prostatitis animal model, method of preparing animal and method of using the animal model to screen for substance that treat human chronic nonbacterial prostatitis

Group 2, claim(s) 13-15, drawn to a method of screening for a substance for preventing human chronic nonbacterial prostatitis

Group 3, claim(s) 16-20, drawn to a method for evaluating the efficacy of a drug for ameliorating human nonbacterial protatitis.

Group 4, claim(s) 24-25, drawn to a pharmaceutical composition for treating or preventing human nonbacterial prostatitis

If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

The inventions listed as Groups I-6 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature of Group I is drawn to a nonbacterial prostatitis animal model, method of preparing animal and method of using the animal model to screen for substance that treat human chronic nonbacterial prostatitis. Groups 2-4 are drawn to multiple distinct methods of use and multiple distinct products that do not share the same inventive concept with each other

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as well as the products of Group I. The claimed inventions of Groups 2-4 recite distinct materials and/or method steps that do not require the claimed invention of Group I, and thus have their own technical features, e.g. drawn to a method of screening for a substance for preventing human chronic nonbacterial prostatitis (Group 2), drawn to a method for evaluating the efficacy of a drug for ameliorating human nonbacterial prostatitis (Group 3), and drawn to a pharmaceutical composition for treating or preventing human nonbacterial prostatitis (Group 4). Further, each of the groups has a technical feature not required for the other groups. For example, drawn to a method for screening for a substance for preventing human chronic nonbacterial prostatitis Group 2 is not required a method of preparing an animal model Group 1. The Groups are also distinct inventions because the method inventions can be performed using other and materially distinct products, such as in vitro assays without the use of the animal model. In addition, the animal model can be used in other methods such as one to understand the basic biology and etiology of nonbacterial prostatitis. Furthermore, because the methods have such divergent purposes and functions as well as effects, the search for one method would not be co-extensive with another method. For example, group 1 is drawn to a method preparing the animal model, group 2 is drawn to a method of screening for substance for preventing nonbacterial prostatitis such as a vaccine while group 3 is drawn to a method of evaluating the efficacy of a drug. In this instant, these methods use different starting material as well as have different effects and objectives. The scope of group 1 does not overlap with the scope of group 2-4; therefore, their searches would not be co-extensive and would be an undue burden to perform a search of the products and methods group together or any combination thereof.

Each invention is directed to a distinct goal, which comprises the use of separate products or methods in order to achieve its respective and intended objective. Thus, it follows from the preceding analysis that the claimed inventions listed as Groups 1 to 13 do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding technical features for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malou C. Gemeniano whose telephone number is 571-272-6451. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on 571-272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any inquiry concerning this communication or earlier communications regarding the formalities should be directed to Patent Analyst Dianiece Jabobs, whose telephone number is (571)-272-0532.

For all other customer support, please call the USPTO Call Center (UCC) at (800)-786-9199.

Malou C. Gemeniano, Ph.D
Examiner, USPTO, AU 1632



DAVE TRONG NGUYEN
SUPERVISORY PATENT EXAMINER